

REMARKS

This responds to the Office Action mailed on January 24, 2005, and the references cited therewith.

By this amendment, claims 1, 4, 5, 7, 10, 13, 15, and 19 were amended, and claim 37 was added. No claims were canceled. As a result, claims 1-5 and 7-37 are now pending in this application. Reconsideration of this application is requested in view of the above amendments and the following remarks. No new matter has been added.

§103 Rejection of the Claims

A. Rejection: Claims 1-3, 7-10, 13-16, 18, 24-28, and 33-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parulski (U.S. 6,836,617) in view of Bidun (WO 2001-63518) and further in view of Altman (U.S. 2001/0036324). It should be noted that the Examiner does not include claims 19-21 and 30-32 in his summary of this rejection, but he discusses these claims in detail in this section.

B. Response: To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to an art worker, to modify the references or combine reference teachings so as to arrive at the claimed invention. Third, the art must provide a reasonable expectation of success. M.P.E.P. § 2143. The teaching or suggestion to arrive at the claimed invention and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure (M.P.E.P. § 2143, citing with favor *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)).

Claim 1 recites "...transferring at least one digital image from a memory associated with a user's digital camera imaging device to a memory at a remote site... and printing a sales receipt for the transaction that includes a thumbnail of the at least one digital image to confirm storage of the at least one digital image." The combination of references fails to teach or suggest the elements of claim 1, as now amended. The Parulski reference is directed to configuring and purchasing a photographic film product by providing at least one photographic film product that

can be configured by a purchaser via a digital communications network. (See Abstract of the Parulski reference). The Examiner points to the Abstract and column 13, lines 43-45 for support of receiving a digital image from an imaging device. However, the image of Parulski is not from a digital camera but from a user's computer. The digital image of Parulski relates to a design criteria of a custom camera that is to be purchased. Furthermore, the Examiner admits that the Parulski reference fails to teach printing a receipt that includes thumbnails of the images stored (see page 4 of Office Action dated January 12, 2005).

The Bidun reference also fails to teach the elements of the invention as now claimed. Bidun teaches an apparatus and method for gathering and transmitting data to remote location (See lines 1 and 2 of the Abstract of Bidun). In addition, the Bidun apparatus and method includes its own imaging device integrated with a kiosk. Users can take a picture using the imaging device of the kiosk and have it stored at another location to conserve precious memory in the user's imaging device. Such a kiosk can be placed at a mall or at a scenic site so people can get a picture of themselves without even having to tote a camera. As a result, Bidun fails to teach the element of transferring at least one digital image from a memory associated with a user's digital camera imaging device to a memory at a remote site. Bidun also fails to teach printing a receipt that includes thumbnails of the images stored, as admitted by the Examiner (see page 4 of Office Action dated January 12, 2005).

It should be pointed out that the Bidun reference even teaches away from the invention as claimed, since Bidun touts the advantage of the user being cameraless. According to the Bidun reference, the kiosk of the Bidun reference "...would eliminate the need to purchase or rent an expensive camera and transport a camera, video equipment, film, memory and/or photos from one location to another." (See page 2, lines 10-12 of the Bidun reference). The Examiner also points out a further teaching away as the Bidun reference teaches against removing memory from an image capture device since it could result in loss of the memory unit and stored data. (See page 2, lines 1-4 of the Bidun reference). This teaching away is evidence against the reasons to combine all the references. This teaching away directly contradicts the Examiner's position that it "...would have been obvious to one of ordinary skill in the art at the time of the invention to have included the well-known step of receiving and accessing at least one digital image by reading memory that had been removed from the digital imaging device..." (See bottom of page

3 of the Office Action dated January 24, 2005). The teaching away set forth above also seems to suggest that one of ordinary skill in the art would not combine Bidun with another reference to obtain a solution to a problem associated with a user's camera.

The Altman reference is directed to systems, processes and products for the storage and retrieval of physical paper documents, electro-optically generated electronic documents, and computer generated electronic documents (See title of Altman). The thrust of such systems and processes is to eliminate additional paper. One of ordinary skill in the art of document handling would not be disposed to produce receipts for all documents as doing so would generate more paper to track. The Altman reference does show thumbnails of documents on a computer screen, but fails to mention printing a sales receipt for a transaction. In fact, the word "sale" was found once as part of the word "wholesale" (see paragraph 74 of the Altman reference). The portion of the reference cited by the examiner for support discusses how images can be shown on a workstation (one is as a thumbnail). The workstation is also attached to a printer "...for production of physical documents. These physical documents include labels...as well as read-outs of logical sets of records, that are retrieved from electronic storage 108." (see paragraph 88 of Altman). There is no teaching or suggestion of a sales receipt or printing of a thumbnail of an image. The Altman reference also fails to teach or suggest anything to do with a camera, much less transferring at least one digital image from a memory associated with a user's digital camera imaging device, as required by claim 1.

Therefore the combination of the Parulski, Bidun and Altman fails to make out a proper *prima facie* case of obviousness against claim 1, as now amended, since the combination simply falls short of the elements recited in claim 1, namely "...transferring at least one digital image from a memory associated with a user's digital camera imaging device to a memory at a remote site... and printing a sales receipt for the transaction that includes a thumbnail of the at least one digital image to confirm storage of the at least one digital image." As pointed out by Applicant, none of the references included these elements. Consequently, one cannot combine these references to yield applicant's invention as now claimed.

In addition, the examiner fails to make out a proper *prima facie* case of obviousness since there is no suggestion or motivation, either in the cited references themselves or in the knowledge generally available to an art worker, to modify the references or combine reference

teachings so as to arrive at the claimed invention. In fact, the Altman reference teaches away from printing a receipt for images received. Altman teaches a system and process for storage and retrieval of physical paper documents, electro-optically generated electronic documents, and computer generated electronic documents. One of the main ideas of such a document retrieval system is to minimize the amount of paper needed to track the physical locations and to build a system and data base to provide an easy way to find documents, as well as an easy way to access the physical documents. The idea of printing receipts of documents that are scanned is contrary to the purpose of such a document retrieval system. Rather than minimize the paper documents, this would add significant amounts of paper and increase the complexity of retrieving the documents in a fast and efficient manner. The system proposed by the Examiner would not “maximize the efficiency of storing and indexing documents” as the Examiner contends, but would decrease the efficiency of storing and indexing documents significantly. The Bidun reference also teaches away from the invention as claimed, as discussed above. The teaching away of the Altman reference and the teaching away of the Bidun reference evidence the lack of a suggestion or motivation to combine or modify the prior art to yield the claimed combination. Accordingly, claim 1 as now amended overcomes the Examiner’s rejection under 35 U.S.C. § 103(a) as being unpatentable over Parulski (U.S. 6,836,617) in view of Bidun (WO 2001-63518) and further in view of Altman (U.S. 2001/0036324).

Claims 2, 3, 8-10, 33 and 34 depend, either directly or indirectly, from claim 1 and include the limitations of claim 1 by their dependency. As a result, each of these claims now overcomes the rejection under 35 USC § 103 (a) as being unpatentable over Parulski (U.S. 6,836,617) in view of Bidun (WO 2001-63518) and further in view of Altman (U.S. 2001/0036324).

Claim 13, as now amended, recites

... removing memory from the digital camera imaging device; inserting the memory from the digital camera imaging device into a memory reader associated with a transaction machine; accessing at least one digital image from the memory from the digital camera imaging device with the transaction machine; conducting at least a portion of a financial transaction at the transaction device for storing the at least one digital image at a remote site, the transaction machine adapted for use by a plurality of customers; and confirming storage of the at least one digital image at the remote site with a receipt.

The Bidun reference teaches away from the invention as claimed, as it touts the advantages of being free of a camera and other equipment related to the camera. Memory is some of the “other equipment” referred to by Bidun. Bidun goes on to spell out the problems with having memory. Bidun states that

“...removing a filled memory unit from the device for later processing is inconvenient and can result in the loss of the memory unit and stored data.. In addition, obtaining additional memory units to replace filled memory units requires the user to purchase and transport multiple memory units which may be cumbersome and expensive.” (See page 2, lines 1-4).

Applicant respectfully submits that the Bidun reference is not properly combinable with the other references since combining this reference with the others to yield Applicant's invention destroys one of the key attributes of the Bidun invention—namely to have a user be free of a camera and other equipment such as memory sticks.

Even if one were to find that Bidun was properly combinable with the other references, the combination would not yield Applicant's invention. In order to make out a proper prima facie case of obviousness, the first requirement is that the prior art references, when combined, must teach or suggest all the claim limitations. The combination suggested by the Examiner falls short of this requirement. Neither the Parulski nor Altman references teach or suggest sending digital images from a digital camera to a remote storage site. In addition, neither Parulski, Bidun, or Altman teach removing memory from the digital camera imaging device. Since these references fall short of key elements, a combination of these references does not yield the missing elements. Furthermore, the teaching away of the Bidun reference is evidence of the lack of a suggestion or motivation to combine or modify the prior art to yield the claimed combination. As mentioned above, Bidun, arguably, may not be properly combinable with the other references because of the teaching, since combining the reference would destroy the purpose of the reference. Accordingly, claim 13, as now amended, overcomes the Examiner's rejection under 35 U.S.C. § 103(a) as being unpatentable over Parulski (U.S. 6,836,617) in view of Bidun (WO 2001-63518) and further in view of Altman (U.S. 2001/0036324).

Claim 14 depends from claim 13 and includes the limitations of claim 13 by its dependency. As a result, claim 13 now overcomes the rejection under 35 USC § 103 (a) as being

unpatentable over Parulski (U.S. 6,836,617) in view of Bidun (WO 2001-63518) and further in view of Altman (U.S. 2001/0036324).

Claim 15, as now amended, recites

...means for transferring digital images from a user's digital camera imaging device memory to a remote site; means for performing at least a portion of a financial transaction in response to storing at least some of the images at the remote site; and means for printing sales receipts for the transactions that include information identifying the stored images, the identifying information including thumbnail images of the stored digital images.

As discussed above, neither the Parulski, Bidun or Altman references teach or suggest sending digital images from a user's digital camera to a remote storage site. As a result, a combination of these references does not yield the missing element. In addition, the Examiner admitted that neither the Parulski or Bidun reference teaches means for printing sales receipts for the transactions that include information identifying the stored images. In addition, Altman, as argued above, does not print a sales receipt in response to storing at least some of the images at the remote site. In short, each of the references cited does not have several elements and therefore the combination of the references also does not include these two elements of claim 15. The Bidun reference also teaches away from the invention as claimed, as it touts the advantages of being free of a camera and other equipment related to the camera. The teaching away of the Bidun reference is evidence of the lack of a suggestion or motivation to combine or modify the prior art to yield the claimed combination. In fact, Bidun, arguably, may not be properly combinable with the other references because of the teaching, since combining the reference would destroy the purpose of the reference. Accordingly, claim 15 as now amended overcomes the Examiner's rejection under 35 U.S.C. § 103(a) as being unpatentable over Parulski (U.S. 6,836,617) in view of Bidun (WO 2001-63518) and further in view of Altman (U.S. 2001/0036324).

Claims 16 and 18 depend, either directly or indirectly, from claim 15 and include the limitations of claim 15 by their dependency. As a result, each of these claims now overcomes the rejection under 35 USC § 103 (a) as being unpatentable over Parulski (U.S. 6,836,617) in view of Bidun (WO 2001-63518) and further in view of Altman (U.S. 2001/0036324).

Claim 19, as now amended, recites

...a processor responsive to the card reader and programmed to perform a point-of-sale financial transaction for sending digital images from a user's digital camera to a remote storage site, the processor confirming storage of digital images at the remote storage site in response to confirmation sent from the remote storage site...

As discussed above neither the Parulski, Bidun or Altman references teach or suggest sending digital images from a user's digital camera to a remote storage site. As a result, a combination of these references does not yield the missing element. In addition, there is no processor programmed to perform a point-of-sale transaction for sending the digital images from a user's digital camera. The Bidun reference also teaches away from the invention as claimed, as it touts the advantages of being free of a camera and other equipment related to the camera. The teaching away of the Bidun reference is evidence of the lack of a suggestion or motivation to combine or modify the prior art to yield the claimed combination. In fact, Bidun, arguably, may not be properly combinable with the other references because of the teaching, since combining the reference would destroy the purpose of the reference. Accordingly, claim 19 as now amended overcomes the Examiner's rejection under 35 U.S.C. § 103(a) as being unpatentable over Parulski (U.S. 6,836,617) in view of Bidun (WO 2001-63518) and further in view of Altman (U.S. 2001/0036324).

C. Rejection: Claims 4-6, 17, 22, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parulski in view of Bidun and further in view of www.telepix.com.

D. Response: Claim 6 was cancelled in a previous amendment and, as a result, will not be discussed as this claim is no longer pending in the application.

The Examiner admits that neither the Parulski reference nor the Bidun reference teach printing a receipt (see page 4 of Office Action dated January 4, 2005). The Examiner cites the www.telepix.com reference for the teaching of a receipt. The only discussion of a receipt appears to be on page 3 of the reference, marked 2X. There is no further discussion of printing a receipt or a discussion detailing the form of the receipt in the www.telepix.com reference (2X). In fact, there is some question as to whether the receipt is a sales receipt. The remaining references appear to rail on the need for an itemized receipt. It would seem these teach away

from having a receipt; however, the Examiner seems to argue that the arguments against an itemized receipt in the references provide the motivation or suggestion to provide an itemized receipt.

Applicant submits that one of ordinary skill would not combine the references that argue against a receipt with the other references. However, even if one were to make the combination, the combination falls short of the invention as claimed. Claims 4 and 5 depend from claim 1 which recites "...printing a sales receipt for the transaction that includes a thumbnail of the at least one digital image to confirm storage of the at least one digital image." There is no mention of this complete element in the references, nor may the references be combined to yield the element in whole.

Claim 17 depends from claim 15. Claim 17 includes the elements of 15 which recites "...means for printing sales receipts for the transactions that include information identifying the stored images, the identifying information including thumbnail images of the stored digital images". Again, there is no mention of this complete element in the references, nor may the references be combined to yield the element in whole.

Claim 22 depends from claim 19. Claim 22 includes the elements of claim 19 which recites

...a processor responsive to the card reader and programmed to perform a point-of-sale financial transaction for sending digital images from a user's digital camera to a remote storage site, the processor confirming storage of digital images at the remote storage site in response to confirmation sent from the remote storage site...

Claim 22 also adds "...a receipt printer coupled to the processor; whereby the processor can command the printer to print out receipts of the transactions." The complete recitations included in claim 22 (and claim 19) do not appear to be specifically taught in the references cited. Accordingly, since the combination of references falls short of the claim language, the claim overcomes the Examiner's rejection under 35 USC § 103(a).

E. Rejection: Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Parulski in view of Bidun as applied to claims 1 and 11 above, and further in view of

Eastman Kodak ("Kodak to acquire 51% stake in Picture Vision", M2 Presswire, February 13, 1998, pg. 1).

F. Response: Claim 12 depends indirectly from claim 1, which recites "...printing a sales receipt for the transaction that includes a thumbnail of the at least one digital image to confirm storage of the at least one digital image..." The Examiner admits that neither the Parulski reference or Bidun reference teaches printing a receipt (see page 4 of Office Action dated January 4, 2005). As a result, the Examiner fails to make out a prima facie case of obviousness for the same reasons as set forth above (such as in section B. of this Response and others) since the Eastman Kodak reference fails to provide this missing element.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and early notification to that effect is earnestly requested. Reconsideration of this application is requested in view of the above amendments and remarks. The Examiner is invited to telephone Applicant's attorney at (612) 373-6977 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 08-2025.

Respectfully submitted,

JOHN F. MEYER

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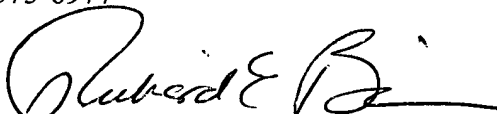
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